

### **REMARKS**

Claims 1,2, 4-6, 11-16 and 22 are pending. By this Reply, claims 6, 11, 14, 16, and 22 have been amended, claim 12 has been canceled, and claims 23 and 24 have been added. Accordingly, claims 1, 2, 4-6, 11-16, and 22-24 are currently at issue.

In Paragraph 2 of the Office Action, the Examiner rejected claims 12, 14 and 22 under 35 U.S.C. §112, second paragraph as being indefinite. Applicant has canceled claim 12 and has made amendments to claims 14 and 22 to address the Examiner's rejections. Applicant submits that the amendments address the rejections.

### **Rejections on the Art**

Applicant has canceled claim 12. This cancellation moots the rejections made in paragraphs 4 and 7 of the Office Action.

In Paragraph 6 of the Office Action, the Examiner rejected claims 1, 2, 4, 5, 6, 11, 13, 14 and 22 under 35 U.S.C. §103 as being unpatentable over German Patent No. DE 29720696 ("German '696") in view of U.S. Patent No. 5,622,389 to Courtney ("Courtney") and Japanese Patent No. 9-970-014 ("Japan '014") and optionally further in view of at least one of the prior art at page 18, lines 12-17 of the specification, Great Britain Patent No. 2174233 ("Great Britain '233"), and U.S. Patent No. 5,290,067 to Langen ("Langen"). Applicant respectfully traverses this rejection as to the claims.

The present invention as claimed is directed to a sticker assembly utilizing a sticker and a vinyl film having a low-tack adhesive layer to form the sticker assembly. The vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing the peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker. In certain embodiments of the invention, a protective layer, or liner, is positioned over the low-tack adhesive layer. The protective layer is also trimmed and then removed when preparing to place the sticker assembly. With the low-tack adhesive, the sticker assembly can be repositioned on the receiving surface or

windshield over and over again. In addition, the receiving surface or windshield is not damaged including any defroster strips on a car window.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. See MPEP §2142; *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

As an initial ground for overcoming the rejection, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because there is no suggestion or motivation to combine the several different references as suggested by the Examiner. It respectfully appears to Applicant that the Examiner's position is based on hindsight reconstruction gained after review of Applicant's disclosure. *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from the prior art absent some suggestion or motivation in the prior art itself to do so).

Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc.*, 231 F.3d 1339, 56 USPQ2d 1641, 1644 (Fed. Cir. 2000).

The Examiner cites a new reference, Courtney, and makes numerous conclusions on pages 4-8 regarding what one of ordinary skill in the art would appreciate. These conclusions,

however, are not supported by specific disclosures in the references themselves, that would give the one of ordinary skill in the art the motivation to combine the several different references as suggested by the Examiner. Applicant discusses these conclusions in greater detail below. The Examiner has merely cited to several different patents in an effort to piece together elements of the prior art to read on Applicant's claimed invention. As discussed above, the suggestion to combine requirement prevents such hindsight reconstruction. Without the requisite motivation, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 2, 4-6 and 11, 13, 14 and 22.

As previously discussed, Claim 1 requires, among other things, that "the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker." This element is not disclosed or suggested in any of the several different references previously cited by the Examiner. German '696 is void of any discussion of trimming. Japan '014 is likewise void of any discussion of trimming. The prior art discussed in the specification merely refer to traditional window stickers with permanent adhesive. Great Britain '233 and Langen also do not disclose or suggest trimming a vinyl film as claimed. The Examiner cites Courtney as disclosing the trimming element. There is no motivation, however, for combining Courtney with the other prior art cited by the Examiner.

The trimming element of the present invention provides several advantages. By trimming the vinyl film so the peripheral edges are essentially in registry, the vinyl film is virtually undetectable. Thus, only the owner of the sticker assembly knows of its presence. This helps to avoid theft of the sticker assembly. It also avoids unsightliness such as when the peripheral edges of the film extend beyond the sticker. This would surely happen in German '696 as there is absolutely no disclosure or suggestion for trimming. In addition, by trimming the vinyl film, more sticker assemblies can be placed on a windshield without overlapping. Also, the edges of the sticker acts as a guide for the trimming as shown in FIG. 6. With the edges of the film trimmed so that the film corresponds in size to the sticker, the sticker assembly can be placed closer to the edge of a windshield, thus minimizing potential blind spots and increasing

the field of vision through the windshield. Finally, by trimming the edges of the vinyl film, a user can more easily carry the assembly without getting hand dirt and oils on the low-tack adhesive, because the assembly is stiffer wherein the peripheral edges of the assembly can be positioned between the fingers and thumb of a user (similar to carrying a compact disk). If the peripheral edges of the film were not trimmed, these film-only edges, extending from the sticker, would fold over when a user attempted to hold the assembly between the fingers and thumb of the user.

Courtney is directed to a bumper device and method wherein a bumper sticker is mounted to a mounting sheet. There is no disclosure or suggestion in Courtney for use with permit stickers on windshields. The mounting sheet can be trimmed to match the shape of the bumper sticker. Velcro strips are used to mount the sheet and bumper sticker to a car bumper. Alternatively, adhesive materials in the form of double-sided tape are used in place of the Velcro strips. While Courtney discloses a trimming step, there is no suggestion in either Courtney or German '696 for combining the references as suggested by the Examiner.

On page 4 of the Office Action, as a motivation to combine the references, the Examiner stated that "German '696's teaching to use the film as a releasable mounting aid for a sticker indicates that the film *should have a shape and size matching that of the sticker/adhesive coating on the sticker*" (emphasis added). There is no indication in German '696 that the film should have a shape and size matching that of the sticker/adhesive coating on the sticker. This statement is an unsupported conclusion and is not a teaching by German '696. In fact, German '696 teaches away from trimming because German '696 promotes a "one size fits all" product, because it states that the format is selected so that the majority and most common stickers can be stuck on it. (See Declaration of Peter K. Kassab, Paragraph 7.) Thus, the film in German '696 is sized such that it can be used with most stickers. Thus, the film must at least be slightly larger than the largest stickers to assure its operability. The film cannot be undersized or else the high-tack adhesive on the sticker will extend past the film and be able to contact the receiving surface, thus rendering the film inoperable for its stated purpose. Accordingly, German '696 teaches to use a film that is larger than the sticker without any suggestion for trimming. One of ordinary

skill in the art, with the knowledge of German '696 would not be led to the trimming step in Courtney because there is no indication in German '696 of a desirability to have the shape and size of the sticker and film match. Such teaching away prevents a *prima facie* case of obvious with the proposed combination of German '696 and Courtney.

Furthermore, trimming is not readily known, as is supported by the attached Declaration of Peter K. Kassab, the sole inventor of the present invention. Indeed, Applicant developed the trimming step subsequent to his initial development of the invention. (Kassab Declaration, Paragraph 5.) Trimming was not immediately apparent to Applicant. It was only until Applicant worked with the film intermediary on different receiving surfaces did the benefits of having the film trimmed to be in registry with peripheral edges of the sticker become apparent. (Kassab Declaration, Paragraph 5.) Thus, the trimming aspect of the invention was not immediately apparent and was only developed after the initial aspects of the invention were developed. (Kassab Declaration, Paragraph 5). Furthermore, over the course of time, Applicant has taken several questions from customers regarding the peripheral edges of the vinyl film extending beyond the peripheral edges of the sticker. (Kassab Declaration, Paragraph 8.) Applicant has had to indicate to the users to trim the edges as disclosed and claimed in the present application. Thus, the trimming element can hardly be considered as obvious. (Kassab Declaration, Paragraphs 4-9.)

In view of the above, German '696 and Courtney are not properly combinable and, therefore, cannot establish a *prima facie* case of obviousness. Accordingly, Applicant submits that claims 1, 2, 4, 5, 6, 11, 14, 14 and 22 are patentably distinct over the cited art.

The majority of the cited art is simply void of the trimming element as claimed. As discussed above, Courtney is not properly combinable with German '696. Thus, the proposed combination cannot establish a *prima facie* case of obviousness with respect to claim 1. Applicant submits that claim 1 is patentably distinct over the cited references.

Claim 2 requires, among other things, "trimming the vinyl film thereby placing peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker." For the

reasons stated with respect to claim 1, Applicant submits that claim 2 is patentably distinct over the cited references.

Claims 4 and 5 depend from claim 2 and include all of the elements of claim 2. Applicant submits that claims 4 and 5 are patentably distinct for the same reasons with respect to claim 2.

As another ground for overcoming the rejection of the other rejected claims, the combination of the several different references does not disclose or suggest all of the elements of the claims as amended.

Claim 6 requires, among other things, that "the vinyl film is trimmed such that peripheral edges of the vinyl film are essentially in registry with peripheral edges of the window sticker" and that "the indicia-bearing sticker is viewable through the window from outside of the vehicle and the vinyl film is undetectable when viewed through the window from outside of the vehicle." For the reasons stated with respect to claim 1, claim 6 is also patentably distinct over the cited references. Applicant notes the Examiner's conclusion that German '696 indicates that the film should have a shape and size matching that of the sticker is simply not supported by German '696, and as discussed above, German '696 actually teaches away from such a conclusion. Applicant submits that claim 6 is patentably distinct over the cited references.

In addition, claim 6, as amended, further requires a "protective layer positioned over the low-tack adhesive" wherein "the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are essentially in registry with peripheral edges of the window sticker." As shown in FIG. 16, the vinyl film 100 has a protective layer 108 or liner. As explained in pages 22-24 of the Specification, the vinyl film 100 and protective layer 108 are trimmed to place the peripheral edges in registry. With the protective layer 108, the assembly is stiffer, which assists in the trimming of the peripheral edges of the sticker because the scissors have better resistance with the stiffer protective layer on the more floppy film. The protective layer 108 also prevents exposure of the film until just before it is to be mounted helping to keep the film as clean as possible and void of dust particles, which could affect adherence to the windshield. None of the cited prior art disclose a protective layer for a film that is trimmed with

the film. As discussed above, German '696 contains no disclosure or suggestion for trimming the film and actually teaches away from using a trimming step. While Courtney discloses a trimming step, Courtney does not disclose or suggest using a protective layer or trimming a protective layer along with the film. There is no disclosure or suggestion in Courtney for using a protective layer with the mounting sheet 11. Because Courtney utilizes Velcro strips, Courtney would not have a need for a protective layer with the mounting sheet. There is also no need for a protective layer if a double-sided tape was used in the Courtney device. With such mounting devices, there is no disclosure or suggestion for trimming a protective layer when trimming the mounting sheet. None of the remaining prior art discloses a protective layer that is trimmed as claimed. Claim 6 requires that the protective layer is trimmed along with the vinyl film such that peripheral edges of the vinyl film and protective layer are essentially in registry. Thus, even if it was proper to combine the several different references as proposed by the Examiner, the proposed combination does not meet all of the elements of claim 6. Accordingly, Applicant submits that claim 6 is patentably distinct over the cited references.

Claim 11 requires, among other things, the step of "trimming the vinyl film thereby placing the peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker." For the reasons stated with respect to claim 1, Applicant submits that claim 11 is patentably distinct over the cited art.

Claim 11 also requires, among other things, providing "a protective layer positioned over the low-tack adhesive" and "trimming the vinyl film and protective layer thereby placing peripheral edges of the vinyl film and protective layer in registry with peripheral edges of the windshield sticker." For the reasons stated with respect to claim 6, Applicant submits that claim 11 is patentably distinct over the cited art.

Claim 13 requires, among other things, "trimming the first strip of vinyl film to correspond in size to the first strip of adhesive on the sticker" and "trimming the second strip of vinyl film to correspond in size to the second strip of adhesive on the sticker." For the reasons stated with respect to claim 1, Applicant submits that claim 13 is patentably distinct over the cited art.

In addition, on pages 7 and 8 of the Office Action, the Examiner stated:

“...it would have been an obvious alternative to use a pair of transparent film strips to cover a pair of adhesive strips instead of using one transparent film to cover a complete adhesive coating the entire surface of the sticker in view of (1) the above noted suggestion in German ‘696 to use transparent film having low tack adhesive as a mounting aid for known stickers, (2) the admitted prior art’s teaching that known stickers include temporary city stickers made from paper having a thin line of adhesive along the side of the sticker rather than a complete adhesive layer across the entire face of the sticker so that the adhesive is not provided over the indicia bearing portion (page 18 lines 12-17) and (2) Langen’s suggestion to removably secure a sticker to window using spaced strips having a repositionable adhesive wherein the indicia is not covered by the repositionable adhesive (figures 2 and 3). The limitation of trimming the strips/the trimmed strips would have been obvious in view of (a) the above noted suggestion from the applied prior art to use a pair of film strips instead of one film strip and (2) the above noted teaching to Courtney to trim the mounting sheet material to match the shape and size of the sticker so that the mounting sheet is virtually undetectable to the casual viewer and potential for theft is reduced by the appearance of permanent affixation (col. 1 lines 61-62; col. 2 lines 24-28, 3-31, 33-46, 50-55).”

For the reasons discussed below, the above statements do not represent a convincing line of reasoning that establishes a *prima facie* case of obviousness with respect to strips of vinyl film as claimed in claim 13.

The Examiner’s statements regarding the several different references does not result in the use of strips of vinyl film that are trimmed in a method of releasably adhering a vehicle windshield sticker to a windshield. First, German ‘696 is completely void of any disclosure or suggestion to use vinyl strips. (See also Kassab Declaration, Paragraph 7.) The prior art temporary permit stickers utilizing spaced strips of adhesive further do not suggest the use of vinyl strips and no convincing line of reasoning follows therefrom. At best, one could only argue to use an entire sheet of film from German ‘696 over the prior art permit sticker that would cover both the strips of adhesive and the indicia bearing portion between the strips of the adhesive. However, that structure is not claimed in claim 13. In addition, such configuration would be undesirable because one could then detect the film over the indicia-bearing portion of

the sticker where there is no adhesive applied. Consistent with the arguments above, the vinyl strips of film over the adhesive strips are undetectable.

Furthermore, even if Langen is read to suggest removably securing a sticker using spaced strips of repositionable adhesive, Langen does not disclose or suggest using strips of vinyl film that are trimmed. As previously discussed, Langen discloses using a repositionable adhesive and release strip including a double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58-59; col. 4, lns. 47-57). The strips in Langen are merely tape strips and there is still no suggestion for using strips of vinyl film with strips of adhesive.

In addition, Langen, does not teach trimming strips of vinyl film. Langen merely discloses the use of a double-sided tape having a repositionable adhesive. (*See e.g.*, col. 3, lns. 58-59; col. 4, lns. 47-57). As there is no disclosure or suggestion of trimming, the adhesive and release liner must initially be made the same size in Langen. Furthermore, neither the tape 34 or the release liner 37 is a vinyl film that is trimmed to correspond in size to a separate strip of adhesive. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is plainly no disclosure or suggestion of a step of trimming a strip of vinyl film to correspond in size to the first strip of adhesive on the sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*See Abstract*). Thus, the proposed combination of any of the references with Langen does not render as obvious, the trimming step as claimed and, therefore, cannot establish a *prima facie* case of obviousness with respect to claim 13.

From the above statements with respect to German '696, the prior art temporary permit stickers and Langen, the Examiner further concludes that trimming the strips would have been obvious in view of above noted suggestion from the applied prior art to use a pair of film strips instead of one film strip. As noted above, the prior art does not support this conclusion because none of the prior art relied upon by the Examiner discloses or suggests the use of a pair of film strips. German '696 is completely void of such teaching. The prior art temporary permit stickers only teaches the use of strips of adhesive, not the use of a pair of film strips. Similarly, Langen

only teaches the use of a strip of repositionable adhesive including a double-sided tape. None of the cited prior art discloses or suggests the use of strips of vinyl film that are trimmed to correspond to adhesive strips as claimed in claim 13. The only disclosure of this element is found in Applicant's specification. Applicant further notes that the trimming of strips was only developed after further experimentation, and not readily apparent. (Kassab Declaration, Paragraph 6.)

Courtney merely discloses trimming an entire mounting sheet to correspond in size to a bumper sticker. Courtney does not disclose or suggest using strips of vinyl film that are trimmed to correspond in size to strips of adhesive. Furthermore, there would be no motivation in Courtney to use strips of film because Courtney only teaches the use of Velcro strips and double-sided tape as mounting structures, thus making the need for strips unnecessary. Rather, Courtney is focused on trimming to size based on the sticker size as opposed to the size of the adhesive strip as in claim 13.

Thus, Applicant submits that the Examiner's proposed combination of the references fails to establish a *prima facie* case of obviousness with respect to claim 13. There is simply no teaching, suggestion or motivation found in any of the references that would have allowed one to produce the invention. The several references further do not support that the use of strips as claimed was within the knowledge generally available to one of ordinary skill in the art. Accordingly, a rejection based on a *prima facie* case of obviousness cannot be supported. M.P.E.P §2143.01. Any attempt to combine the references as suggested is a plain example of impermissible hindsight reconstruction using Applicant's claims as the blueprint for such combination. Accordingly, claim 13 is patentably distinct over the cited art.

Also, Applicant notes and appreciates the indication of allowable subject matter with respect to claim 16. Applicant submits that the Examiner's reasons for allowance equally apply to claim 13. Accordingly and consistent with the Examiner's reasoning regarding claim 16, although the use of space strips of adhesive is known in the prior art, there is no motivation to modify the film of the prior art so as to include the step of placing strips of vinyl film coinciding with the strips of adhesive. It is noted that the prior art, such as German '696, like Great Britain

'256, does not disclose using strips of vinyl film, but teaches covering the entire surface of a vehicle window sticker with the film. Applicant submits that claim 13 is patentably distinct over the cited art.

Claim 14 requires, among other things, that "the strips are trimmed to correspond in size to the strips of adhesive." Claim 14 also requires that "the strips are undetectable when viewable through the windshield from outside of the vehicle." Claim 14 further requires "a first protective layer" and "a second protective layer" that are trimmed to correspond in size to the strips of adhesive. For the reasons stated with respect to claims 1, 6 and 13, Applicant submits that claim 14 is patentably distinct over the cited art. In addition, it is noted that a user can cut and trim strips of vinyl film with the protective layer to size based on the strip of adhesive used on the sticker, and safely store and use these trimmed strips at a later date as needed.

Claim 22 requires, among other things, strips of vinyl film wherein "the strips are trimmed to correspond in size to the strips of adhesive." For the reasons stated with respect to claims 1 and 13, Applicant submits that claim 22 is patentably distinct over the cited art.

In Paragraph 8 of the Office Action, the Examiner rejected claims 1, 2, 4, 11-14 and 22 under 35 U.S.C. §103 as being unpatentable over Langen in view of U.S. Patent No. 4,935,288 to Honaker ("Honaker") or U.S. Patent No. 4,670,490 to Yoshida et al. ("Yoshida"). Applicant respectfully traverses this rejection in view of the amended claims.

As discussed above, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. See MPEP ' 2142; *In re Vaeck*, 20 USPQ.2d 1438 (Fed. Cir. 1991).

As an initial ground for overcoming the rejection, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because there is no suggestion or motivation to combine Langen and Honaker or Yoshida as suggested by the Examiner. Langen is directed to a repositional window pricing label while Honaker is directed to a coated

laser printed label. Even though both Langen and Honaker are directed to labels, the Examiner has still failed to cite to a specific disclosure in any of the references that would have given one the motivation to combine them as proposed by the Examiner. Consequently, the proposed combination cannot establish a *prima facie* case of obviousness with respect to the claims. M.P.E.P §2143.02.

As another ground for overcoming the rejection, the combination of Langen, Honaker and Yoshida does not disclose or suggest all of the elements of the claims as amended.

Claim 1 requires, among other things, that "the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker." This element is not disclosed or suggested in Langen or Honaker. Honaker and Yoshida are completely void of any such disclosure. In addition, Langen does not teach cutting a vinyl film to have peripheral edges in registry with the sticker. Langen discloses the use of a repositionable adhesive and release strip and the use of double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58–59; col. 4, lns. 47–57). The slitting and bursting reference in Langen refers to the web 12, not to the film. As there is no disclosure or suggestion of trimming, the adhesive and release liner must initially be made the same size in Langen. The structure of claim 1 is distinguishable from Langen because the film of the claimed invention has a trimmed edge and the strip in Langen does not. This structural difference is present in the end product. *See* M.P.E.P. §2113. Furthermore, in the double-sided tape embodiment, neither the tape 34 or the release liner 37 is a vinyl film that is trimmed to be in registry with the sticker. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is plainly no disclosure or suggestion of a step of trimming a vinyl film to correspond in size to a sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*See* Abstract). And as discussed, the slitting and bursting reference is for the web 12 and not to the tape 34.

As discussed, the trimming element of the present invention provides several advantages. By trimming the vinyl film so the peripheral edges are essentially in registry, the vinyl film is virtually undetectable. Thus, only the owner of the sticker assembly knows of its presence. This helps to avoid theft of the sticker assembly. It also avoids unsightliness such as when the peripheral edges of the film extend beyond the sticker. In addition, by trimming the vinyl film, more sticker assemblies can be placed on a windshield without overlapping. Also, the edges of the sticker acts as a guide for the trimming as shown in FIG. 6.

The cited art is simply void of the trimming element as claimed. Thus, the proposed combination of Langen and Honaker does not render the trimming step as claimed obvious. Accordingly, the proposed combination cannot establish a *prima facie* case of obviousness with respect to claim 1. Applicant submits that claim 1 is patentably distinct over the cited references.

Claim 2 requires, among other things, "trimming the vinyl film thereby placing peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker." For the reasons stated with respect to claim 1, Applicant submits that claim 2 is patentably distinct over the cited references. In addition, the Examiner indicates at page 11 of the Office Action that the claimed trimming step reads on the slitting and bursting for defining edges 15, 15, 18 described by Langen. Langen describes that the web 12 may optionally be slit and burst to remove the marginal portions of the web 12 along the edges 15,16. The web is burst to form perforations 18. (Col. 4, Ins. 19-26.) These operations, however, are performed on the web 12, not the tape 34 as indicated by the Examiner meets the film element of the claim. Thus, Langen does not disclose the trimming the vinyl film. Instead, Langen discloses trimming the web 12, which would merely correspond to the sticker element of the claim. Accordingly, Applicant submits that claim 2 is patentably distinct over the cited references.

Claim 4 depends from claim 2 and includes all of the elements of claim 2. Applicant submits that claim 4 is patentably distinct for the same reasons with respect to claim 2.

Claim 6 requires, among other things, that "the vinyl film is trimmed such that peripheral edges of the vinyl film are essentially in registry with peripheral edges of the window sticker" and that "the indicia-bearing sticker is viewable through the window from outside of the vehicle

and the vinyl film is undetectable when viewed through the window from outside of the vehicle.” For the reasons stated with respect to claim 1, claim 6 is also patentably distinct over the cited references.

Furthermore, none of the cited art disclose or suggest the trimming element such that the vinyl film is undetectable when viewed through the window from outside the vehicle. The trimming element helps in making the vinyl film virtually undetectable when mounted on the window so that only its owner would know the sticker is releasably adhered. Applicant submits that claim 6 is patentably distinct over the cited references.

In addition, claim 6, as amended, further requires a “protective layer positioned over the low-tack adhesive” wherein “the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are essentially in registry with peripheral edges of the window sticker.” As shown in FIG. 16, the vinyl film 100 has a protective layer 108. As explained in pages 22-24 of the Specification, the vinyl film 100 and protective layer 108 are trimmed to place the peripheral edges in registry. None of the cited prior art disclose a protective layer for a film that is trimmed with the film as claimed. Because Langen utilizes adhesive strips and double-sided tape, Langen would not have a need for a protective layer that is trimmed as claimed. With such mounting devices, there is no disclosure or suggestion for trimming a protective layer when trimming the film. None of the remaining prior art discloses a protective layer that is trimmed as claimed. Claim 6 requires that the protective layer is trimmed along with the vinyl film such that peripheral edges of the vinyl film and protective layer are essentially in registry. Thus, even if it was proper to combine the references as proposed by the Examiner, the proposed combination does not meet all of the elements of claim 6. Accordingly, Applicant submits that claim 6 is patentably distinct over the cited references.

Claim 11 requires, among other things, the step of “trimming the vinyl film thereby placing the peripheral edges of the vinyl film in registry with peripheral edges of the windshield sticker.” For the reasons stated with respect to claims 1, 2 and 6 above, Applicant submits that claim 11 is patentably distinct over the cited art.

Applicant has cancelled claim 12 thus mooting this rejection.

Claim 13 requires, among other things, "trimming the first strip of vinyl film to correspond in size to the first strip of adhesive on the sticker" and "trimming the second strip of vinyl film to correspond in size to the second strip of adhesive on the sticker." For the reasons stated with respect to claim 1, Applicant submits that claim 13 is patentably distinct over the cited art.

Further as discussed above, Langen does not teach cutting strips of vinyl film. Langen discloses the use of a repositionable adhesive and release strip and the use of double-sided tape 34 having a release liner 37. (*See e.g.*, col. 3, lns. 58-59; col. 4, lns. 47-57.) Neither the tape 34 or the release liner 37 is a vinyl film that is trimmed and to correspond in size to a separate strip of adhesive. The tape 34 is an integral assembly with adhesive on both its sides. Thus, if a double-sided tape is used, the release liner is automatically sized wherein there is no need for another trimming operation. There is no disclosure or suggestion of a step of trimming a strip of vinyl film to correspond in size to the first strip of adhesive on the sticker. In fact, Langen teaches away from such a configuration as it discloses that the application of adhesive and protective strips is done simultaneously (*See Abstract*).

On page 11 of the office action, the Examiner concluded that the limitation of trimming the strips reads on the slitting and bursting for defining edges 15, 15, 18 described by Langen. However, as discussed above with respect to claim 2, the slitting and bursting steps are performed on the web 12, not the tape 34 as indicated by the Examiner as the element that meets the film element of the claim. Langen does not disclose or suggest that the described slitting and bursting steps be performed on the strips 34. Thus, Langen does not disclose the trimming strips of vinyl film as claimed. Instead, Langen discloses trimming the web 12. Thus, the proposed combination of the cited references does not render the trimming step as claimed obvious and, therefore, cannot establish a *prima facie* case of obviousness with respect to claim 13.

Claim 14 requires, among other things, that "the strips are trimmed to correspond in size to the strips of adhesive." Claim 14 as amended also requires a "protective layer" that is trimmed as discussed above. Claim 14 also requires that "the strips are undetectable when viewable through the windshield from outside of the vehicle." For the reasons stated with respect

to claims 1, 6 and 13 above, Applicant submits that claim 14 is patentably distinct over the cited art.

Claim 22 requires, among other things, strips of vinyl film wherein "the strips are trimmed to correspond in size to the strips of adhesive." For the reasons stated with respect to claims 1 and 13, Applicant submits that claim 22 is patentably distinct over the cited art.

Applicant acknowledges and appreciates the Examiner's allowance of claim 16 in Paragraph 9 of the office action.

Applicant has added claims 23 and 24. Claim 23 is directed to an intermediary for use in a sticker assembly for a car window. Claim 24 is directed to a sticker assembly utilizing a strip of vinyl film that corresponds to a strip of adhesive on a sticker. For the reasons stated above with respect to the pending claims, Applicant submits that claim 23 is patentably distinct over the cited references.

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**CONCLUSION**

In view of the above, it is submitted the application is in condition for allowance. Such action is respectfully requested. Further, the Examiner is requested to contact the undersigned if the Examiner has any questions concerning this Reply or if it will expedite the progress of this application.

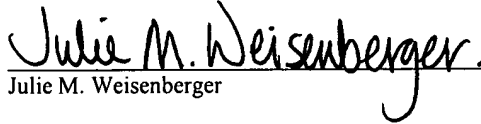
Respectfully submitted,

Date: October 20, 2004

By: 

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I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID, IN AN ENVELOPE ADDRESSED TO MAIL STOP AMENDMENT. COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, ON OCTOBER 20, 2004.

  
Julie M. Weisenberger